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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)	
50588/289	

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Application Number	Filed
09/728,672	December 1, 2000
First Named Inventor	
John Manning	
Art Unit	**Examiner**
2614	5562

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☐ attorney or agent of record. Registration number _____
- ☑ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 **43,548**

Signature

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July 25, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

MAIL STOP AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mai-lan Tomsen

Attorney Docket No.: 50588/289

Application No. 09/728,672

Group Art Unit: 2614

Filed: December 1, 2000

Confirmation No. 5562

For: METHOD AND SYSTEM TO SAVE CONTEXT FOR DEFERRED TRANSACTION VIA INTERACTIVE TELEVISION

Examiner: John Manning

PRE-APPEAL BRIEF REQUEST FOR REVIEW

TO THE COMMISSIONER FOR PATENTS:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, Applicant requests review of the rejection of claims 1, 3, 5, 7-9, and 23-43 in the above-referenced application. As set forth in detail below, clear errors have been made during examination, and essential elements required to establish a *prima facie* rejection are missing.

In the Office Action of March 27, 2006 (the "Office Action"), each of the pending independent claims—claims 1, 23, and 40—were rejected as unpatentable under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,282,713 ("Kitsukawa") and U.S. Patent No. U.S. Patent No. 6,032,130 ("Alloul").

Independent claims 1 and 23 both recite storing and retrieving context information relating to a transaction, the context information indicating a context of the user within the transaction. The only other independent claim—claim 40—recites storing and retrieving a particular type of "context information" relating to the transaction, namely, "a snapshot of at least a portion of the broadcast segment relating to the transaction." None of the cited references, whether considered alone or in combination, contain disclosure sufficient to meet these limitations.

In the Office Action, the Examiner indicated that Alloul teaches "retrieving context information to resume the transaction so as to give the user more time to save up money to complete the transaction and to organize partially completed transactions."[1] Office Action, page 6. In doing so, the Examiner cited to Alloul at col. 8, lines 30-45 and col. 6, lines 6-19. Id. However, the cited portions of Alloul (and the remainder of Alloul) fail to disclose or suggest retrieving context information. Moreover, although Alloul does indicate that its purpose is to allow the user more time to save money to complete a transaction, this purpose is not served by storing and retrieving context information, so its recition by the Examiner does nothing to show any motivation for modification of Alloul/Kitsukawa to include storing and/or retrieving context information.

As explicitly defined in the claim, "context information" must "indicat[e] a context of the user within the transaction." Examples of "context information" can be found in the pending dependent claims, including: a portion of a broadcast segment (claim 5); information previously entered by a user in connection with a transaction (claim 27); one or more URLs of websites accessed in connection with the transaction (claim 28); content retrieved from websites in connection with the transaction (claim 29); and a snapshot of the broadcast segment relating to the transaction (claim 30 and independent claim 40). Alloul does not disclose or suggest storing or retrieving such "context information."

To the contrary, Alloul discloses merely recalling the presence of items in a shopping cart during a subsequent browsing session. See, e.g., col. 6, lines 19-21 ("Each time the customer starts the purchasing application for another browsing session, these

[1] It should also be noted that the Examiner stated in the Office Action that "Kitsukawa fails to disclose" and "Alloul teaches" "placing items in a shopping cart for display [of] the items . . . and automatically deferring the transaction . . . ." Office Action, pages 5-6. It is not understood why these features, even if they were taught in Alloul, are relevant, given that claim 1 does not contain such language, nor do any of the other pending independent claims. It appears as though this language may have been copied from a related case filed by the present Applicant, which does contain similar claim language.

items are found in the personal shopping cart."). In Alloul, this is the **only** type of data or information that is saved during a transaction and/or recalled during a recommencement of the transaction. See, e.g., col. 8, lines 34-35 ("The data **related to the products left in the shopping cart** is stored . . . .") (emphasis added). In fact, even the portion of Alloul cited by the Examiner indicates that only the items themselves are saved and retrieved. To illustrate, the first portion of Alloul cited by the Examiner indicates that "[t]he data **related to the products left in the shopping cart** is stored locally." Col. 8, lines 34-35 (emphasis added). Likewise, the second portion of Alloul cited by the Examiner indicates that "the customer may leave selected items in his personal shopping cart [and] keep them there for future transaction" and further that "items that are not to be purchased during the current browsing session may be kept in the same personal purchasing cart for any desired period." Col. 6, lines 11-19. Both of these cited portions indicate that the items themselves—as opposed to "context information" "indicating a context of the user within the transaction"—are stored and retrieved.

As argued in a previous response, the items making up the transaction cannot reasonably be considered "context information." These items are what make up the transaction itself, rather than providing a context of the user within the transaction. The items to be purchased **must** be saved in order to resume a transaction, but they do not provide or indicate any context of the user within the transaction. These items are therefore the bare minimum amount of information that must be saved in order to resume a transaction. Accordingly, if such items could be considered "context information," the "context information" claim language would be rendered entirely meaningless. After all, storage and retrieval of the purchase items themselves **must** take place in order to defer a transaction. A claim construction that renders some of the claim language without limiting meaning will typically be rejected. See, e.g., Gen. Am. Transp. Corp. v. Cryo-Trans, Inc.,

93 F.3d 766, 770 (Fed. Cir. 1996) (rejecting the district court's claim construction because it rendered some of the claim language superfluous). More importantly, it is unreasonable to construe the items that make up the very existence of a transaction itself as being encompassed by "context information" that "indicat[es] a context of the user within the transaction."

Even if Alloul disclosed the "context information limitations" discussed above—which it doesn't—the Examiner has failed to provide any indication of a motivation to combine Kitsukawa and Alloul. It argued in the most recent response that, if anything, Kitsukawa teaches away from Alloul, in that the deferral of the viewing of an advertisement (Kitsukawa) would not provide motivation to incorporate the deferral of a transaction (Alloul). To the contrary, a person who decides to defer an advertisement presumably has not yet made a purchasing decision, hence the need for further convincing via further viewing of the advertisement. The Examiner responded to this argument by pointing out that the advertisements could eventually lead to a transaction. Office Action, page 3. Even if true, but this observation provides no motivation for subsequently **deferring** a transaction. The mere fact that references can be combined is insufficient to establish obviousness, unless the prior art also suggest the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990). It is therefore submitted that the Examiner has failed to establish a *prima facie* case of obviousness.

The Examiner also committed clear error in rejecting claim 40 over Kitsukawa and Alloul. As mentioned above, claim 40 is, at least in part, narrower than claims 1 and 23, in that it recites storage and retrieval of a specific type of context information, namely, a snapshot of at least a portion of a broadcast segment relating to a transaction. The Kitsukawa/Alloul combination does not teach or suggest storing or retrieving a broadcast segment snapshot. The Examiner indicated in the Office Action that he "interprets the

advertising information [of Kitsukawa] to a snapshot of a 'broadcast segment.'" Office Action, page 3. This is an unreasonable interpretation. Kitsukawa's advertising information "may be received **prior to** receipt of the [broadcast]," col. 2, lines 29-30 (emphasis added), and may also "be displayed by superimposing the information over the broadcast of the television program." Col. 2, lines 55-57. If the Examiner's interpretation were accepted, one would be forced to conclude that a snapshot of a broadcast could be received prior to receipt of the broadcast segment itself and that Kitsukawa provides for superimposing a snapshot of the broadcast over the broadcast itself. The absurdity of this result illustrates that Kitsukawa's "advertising information" cannot be reasonably interpreted as encompassing a "snapshot", as claimed in claim 40.

For at least the foregoing reasons, Applicant submits that claims 1, 3, 5, 7-9, and 23-43 are allowable over the art that has been cited and applied by the Examiner. Applicant therefore requests withdrawal of the rejection of the pending claims and allowance of the application.

Respectfully submitted,

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